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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,885	09/28/2001	Joseph Paul Polifroni	8236-PA02	3477

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BROWN, MARTIN, HALLER & MCCLAIN LLP  
1660 UNION STREET  
SAN DIEGO, CA 92101-2926

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/965,885

Applicant(s)

Polifroni

Examiner

Anthony D. Stashick

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-18, 23 and 24 is/are rejected.
- 7) ☒ Claim(s) 7-10 and 19-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

DETAILED ACTION

*Election/Restrictions*

1. Claims 26-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7.
2. This application contains claims drawn to an invention nonelected without traverse in Paper No. 7. A complete reply to the rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Frese, Jr. 2,959,875. Frese, Jr. '875 discloses all the limitations of the claims including the following: a member 24 having a periphery shaped to conform to at least part of the upper periphery of the sole of a wearer's foot; the

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member having an upper surface (that which faces the foot) and a lower surface (that which faces the shoe); the member contoured to follow the contours of the sole of the wearer (See Figures 3 and 4); the member having an heel region 22 at one end and a toe region 24 at the other end with an arch region located there between; each region is designed to underlie the user's foot when used; a textured, slip-resistant surface portion 26, 28 extending over at least part of the at least one of the surfaces of the arch support member; the slip-resistant surface portion covering an area equal to at least one quarter of the surface area of the lower surface (See Figure 4); the slip resistant portion is provided in the lower surface (figure 4); the slip-resistant surface is provided on the upper surface (see Figure 3); the slip resistant portion is provided on both the upper and lower surfaces (see Figures 3 and 4).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-4, 11-14 and 23-24 are rejected under 35

U.S.C. 103(a) as being unpatentable over Frese, Jr. 2,959,875.

Frese, Jr. '875 discloses all the limitations substantially as claimed including the following: a support 24 member having a periphery that is shaped to conform to at least a periphery of the sole of a wearer's footwear (see Figures 3 and 4); the member having an upper surface (Figure 3), lower surface (Figure 4) and being contoured to follow the contours of the sole of a wearer's foot (see Figures 3 and 4); the member having a heel region 22, toe region 24 and arch region (that located between 22 and 24) all designed to underlie the user's foot; at least the heel region of the lower surface having a slip resistant surface portion 26 for resisting slipping of the element relative to the sole of a shoe; a second slip resistant portion 28 in the toe region of the lower surface; the upper surface has a slip-resistant portion 26, 28 extending over at least a part of the upper surface; the slip-resistant portions are provided in predetermined areas of the heel and toe regions of the upper surface; the slip-resistant material is a layer secured to the lower surface (by stitching 32, 36); the slip-resistant material is rubber (foam rubber); the lower surface has indents in the

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heel and toe region where the slip-resistant material is mounted flush (that where 26 and 28 are mounted). Frese, Jr. '875 does not specifically disclose the height or thickness of the slip-resistant material. With respect to the limitations of the peak of the roughness of the slip-resistant material, it appears that it would have been a mere matter of testing and optimization to find the height necessary of the slip-resistant material to provide the desired slip prevention.

7. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frese, Jr. 2,959,875 as applied to claim 1 above in view of Wood 1,867,461. Frese, Jr. '875 as applied to claim 1 above discloses all the limitations of the claims except for the slip-resistant material extending over the entire lower and upper surfaces. Wood '431 teaches that it is desirable to have slip resistant material over the entire lower surface of a support to aid in prevent the user's foot from slipping on the support. Therefore, since the slip resistant material of Frese, Jr. '875 is located in the same place over the lower surface as it is in the upper surface, it would have been obvious to make the slip-resistant material extend over the entire upper and lower surface of Frese, Jr. '875 to prevent any sized foot placed within the shoe from slipping in the shoe and to prevent

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the insert from slipping with respect to the inside of the shoe during use.

#### *Allowable Subject Matter*

8. Claim 25 is allowed over the prior art of record.
9. Claims 7-10 and 19-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D. Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday-Thursday, 6:00 am until 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

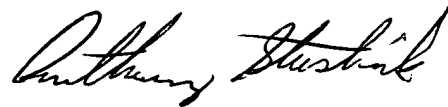
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D. Stashick  
Primary Examiner  
Art Unit 3728

ADS  
June 14, 2003